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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/585,339

06/02/2000

Nobuhiro Miahima

46080-033

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01/26/2006

MCDERMOTT WILL & EMERY LLP
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EXAMINER

THOMPSON, JAMES A

ART UNIT

PAPER NUMBER

2624

DATE MAILED: 01/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/585,339

Applicant(s)

MAHIMA ET AL.

Examiner

James A. Thompson

Art Unit

2624

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 12 January 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1,2,4-16 and 18-23.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 12 January 2006 have been fully considered but they are not persuasive.

Regarding page 12, line 18 to page 13, line 16: Applicant alleges that Stephenson (US Patent 5,757,388) does not disclose a preparatory operation involving a printer, but instead discloses a preparatory operation involving a camera. Applicant then quotes column 3, line 65 to column 4, line 1 of Stephenson.

Examiner responds that, by incompletely quoting the portion of Stephenson cited by Examiner (column 3, line 65 to column 4, line 6 of Stephenson), Applicant presents a false conclusion. The remainder of the cited portion of Stephenson states, "Timing signals transmitted through active socket 20 and active latch 24 are used to *synchronize display modulation and the printer data reception*. Active latch 24 is used to signal start of transmission. Transmission can be synchronized by embedding timing signals into the camera display signal." [column 4, lines 1-6 of Stephenson] [emphasis added]. Thus, as set forth in detail on page 8 of the previous office action, dated 02 September 2005 and mailed 21 September 2005, the printing unit is controlled by the control unit so as to prepare for image forming according to the image data from the external device [camera]. By synchronizing the display modulation of the camera and the data reception of the printer, the printer is prepared to form an image according to the image data from the camera.

Furthermore, since the preparation of the printer is performed based on signal transmissions between the camera and

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the printer, the preparation is clearly not the result of user input, but is performed as an automatic synchronization.

Regarding page 13, line 17 to page 14, line 17: As clearly set forth on page 11, lines 2-7 of said previous office action, "The power supply is controlled, and thus the printer is able to print or not print based on the readiness condition of the printer (column 3, lines 45-53 of Stephenson), which includes whether (first logical level) or not (second logical level) the printer and the camera are secured (column 2, lines 60-64 of Stephenson)." Regardless of operator input, the printer will not print unless the printer and camera are secured. When a printer prints, clearly the amount of power required increases compared with when a printer is simply turned on and idle. Thus, the power supply of the printer is controlled based on whether or not the camera and the printer are secured. While an operator input to print may also be necessary, it is not sufficient to cause printing. The control signal that indicates that the printer and camera are secured is necessary, and thus the control unit controls whether or not printing occurs.

Regarding page 14, line 18 to page 16, line 11: *Applicant alleges* that Meese (US Patent 4,532,418) is non-analogous art and that Examiner has relied upon improper hindsight reasoning in making the obviousness rejection.

Examiner response: Applicant is respectfully reminded that it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Meese is reasonably

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pertinent to a particular problem with which Applicant was concerned, namely the collection of money in exchange for the provision of electricity.

Furthermore, Applicant suggests that, since Meese is related to charging for electricity provided to electric vehicles, it is non-analogous art and one of ordinary skill in the art at the time of the invention would not have knowledge of Meese. Applicant is respectfully reminded that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Meese would clearly have suggested to one of ordinary skill in the art at the time of the invention that a handling unit can be used to collect a charge for electricity provided to a device that consumes electricity. Instead of electric cars, as taught by Meese, the device would be an image forming apparatus.

Both an electric car and an image forming apparatus require electricity to operate, and electricity costs money. Thus, one of ordinary skill in the art at the time of the invention would clearly have been motivated to employ a handling unit that collects a charge for the electricity provided to a customer for the purpose of recharging an image forming apparatus. One of ordinary skill in the art at the time of the invention would not have had to look to Applicant's invention to figure out that one can collect a monetary charge for the provision of electricity

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to a customer, as anyone receiving a regular electricity bill at the time of the invention would easily attest. Thus, the motivation to combine Meese with the other prior art references would clearly be within the grasp of one of ordinary skill in the art at the time of the invention. Furthermore, even if Applicant were to argue that charging for electricity would not have been something one of ordinary skill in the art at the time of the invention would have understood, the motivation to combine the references is found directly in the Meese reference itself, as demonstrated on page 31, lines 27-30 of said previous office action. Thus, clearly no improper hindsight has been used. Applicant is respectfully reminded that it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Regarding page 16, lines 14-17: The claims have been fully demonstrated to be fully taught by the prior art of record. Accordingly, all grounds of rejection presented in said previous office action are maintained.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Thompson whose telephone number is 571-272-7441. The examiner can normally be reached on 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James A. Thompson
Examiner
Art Unit 2624


20 January 2006



THOMAS D. [illegible]
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